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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,695	07/27/2006	Masaharu Akamatsu	59559.00033	8439

32294 7590 08/18/2008  
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EXAMINER
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BODAWALA, DIMPLE N

ART UNIT	PAPER NUMBER
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1791

MAIL DATE	DELIVERY MODE
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08/18/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/587,695	<b>Applicant(s)</b> AKAMATSU, MASA HARU	
	<b>Examiner</b> DIMPLE N. BODAWALA	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/19/2008</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

- Claims 1-5 are pending.
- Claims 6-10 are withdrawn.

### ***Response to Amendment***

In view of the amendment filed on 5/19/2008 following rejection is maintained as a reason of record from the previous office action mailed on 12/19/2007.

- Rejection of claims 1-5 under 35 USC 103(a) as being unpatentable over Miyashita et al. (US 5,558,015) in view of Coluzzi (US 5,051,083).

### ***Response to Arguments***

1. Applicant's arguments filed on 5/19/2008 have been fully considered but they are not persuasive.
2. Applicant argues that previous office action fails to establish a *prima facie* case of obviousness for the rejection of claims 1-5 under 35 USC 103(a) based on the teaching of Miyashita et al. (US 5,558,015) in view of Coluzzi (US 5,051,083). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as

it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

3. Applicant suggests that the prior art, Miyashita et al. (US 5,558,015) discloses a lower bolster includes heat insulating plate which is located on a side of the substrate facing the second mold not the first mold. Heat insulating plate is mounted to the upper bolster, therefore, the lower bolster does not comprise heat insulating plate. Applicant further argues that the combination of Miyashita et al. (US 5,558,015) and Coluzzi (US 5,051,083) fail to teach or suggest at least second mold comprises a substrate, heat insulating member disposed on a side of the substrate which side faces the first mold, and a machining member disposed on a side of the heat insulating member which side faces the first mold and comprising irregularities on a surface facing the first mold; and a heating processing section configured to heat the to-be-machined member to a molding temperature higher than a state change point of a material which constitute the to-be-machined member as cited in claim 1 of the instant application.

4. Applicant's all arguments are fully considered, but not found persuasive because the prior art Miyashita et al. (US 5,558,015) discloses an

invention comprises a second mold, wherein second mold comprises a substrate blank (40). It further suggests that the substrate is disposed on the second mold such a way that the upper surface of the substrate is facing toward first mold and lower surface of the substrate is facing toward the second mold, and, thus, inherently suggests that the substrate is facing the second mold. It further discloses an invention with heat insulating members (10a,10b) disposed on a side of the substrate and heat processing sections (11a,11b) for heating the first and second molds, wherein heating sections are disposed between the heat insulating member and a substrate (See figures 1, 4-6, 8 and 9), wherein heat processing section are capable of heating the machining member to a molding temperature higher than a state change point of a material. However, function of the heat processing section as cited in the claim of the instant application is defined the intended use of the structural element, and, we know that there is no patentability weight for the intended use in the apparatus subject matter. Intended use has been continuously held not to be germane to determining the patentability of the apparatus, *In re Finsterwalder*, 168 USPQ 530. The manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, *In re Casey*, 152 USPQ 235, 238. Purpose to which apparatus is to be put and expression relating apparatus to contents thereof

during the intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault*, 164 USPQ 666. A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations, *Ex parte Masham*, 2 USPQ2d 1647. As we know that the claiming of new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable, *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

5. Furthermore, the prior art discloses all claimed structural limitation as discussed in the previous office action, and also described below. If prior art discloses all claimed structural limitation with the desired function, but the position of the structural elements quite different than the instant application. As we know that the manner or method in which a machine is to be utilized is not germane to the issue of patentability of machine itself, *In re Casey*, 152 USPQ 235,238. It has been recognized that to shift location of parts when the operation of the device is not otherwise changed is within the level of ordinary skill in the art, *In re Japikse*, 86 USPQ 70; *In re Gazda*, 104 USPQ 400. If prior art discloses claimed structural limitation with the desired function, therefore, the change of location of the structural limitation

does not differentiate the function of the apparatus, and has no patentability weight.

6. Therefore, the rejection of claims 1-5 under 35 USC 103(a) as being unpatentable over Miyashita et al. (US 5,558,015) in view of Coluzzi (US 5,051,083) is maintained.

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**8. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyashita et al. (U S Patent No. 5,558,015) in view of Coluzzi (U S Patent No. 5,051,083).**

9. Miyashita et al. ('015) discloses a hot press apparatus as a press molding apparatus which comprises an upper bolster (7) as a first mold; a lower bolster (6) as a second mold, wherein second mold is disposed to face the first mold (7) such that the second mold can advanced and retreat by the pneumatic cylinder (14) (See figure 1 and 4). It further teaches that the mold includes the substrate (40) and heat insulating member (10a, 10b) which is disposed on a side of the substrate (40) which side faces the first mold (7) (See figure 1). It further discloses a heating processing section (11a, 11b) for heating the first mold and second mold (See figure 1), wherein the heating

section (11a,11b) is disposed between the heat insulating member (10a,10b) and plate (38a, 38b) (See figure 1), wherein the heating section is involved to heat first and second mold. It further discloses a loading processing section which is involved to load the substrate of perform on the mold (See col.5 lines 30-35). It further discloses a transfer processing section for pressing the upper mold against the lower mold (See col.6 lines 18-41).

10. Miyashita et al. ('015) discloses all claimed structural limitations as discussed above, but fails to teach or suggest a machining member with irregularities.

11. In the analogous art, Coluzzi ('083) discloses a press molding apparatus which is involved to form multiple impression on the plastic plate, wherein the apparatus comprises a first mold (9), a second mold (5), a plastic plate (4) as a mold preform, an insulating plate (6), and an original plate (19) as a machining member having an engraved design (19b) as an irregularities which can be transferred to the preform (4) and involved to provide the desired pattern on the preform during the press molding operation (See figures 2 and 5; col. 5 lines 39-45).

12. Here, claims disclose some of claimed structural limitations such as a loading processing section, a heating processing section, and a transfer processing section, which are involved for an intended uses. As we know that

intended use has been continuously held not to be germane to determining the patentability of the apparatus, *In re Finsterwalder*, 168 USPQ 530. The manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, *In re Casey*, 152 USPQ 235,238.

Purpose to which apparatus is to be put and expression relating the apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault*, 164 USPQ 666. A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations, *Ex parte Masham*, 2 USPQ2d 1647. Thus, it can be understandable that the prior arts disclose all claimed structural limitations with uses of them as defined in the claim of the instant application.

13. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the invention of Miyashita et al. ('015) by providing a machining member with irregularities because such an alignment is involved to imprint desired pattern on the preform during the molding operation as suggested by Coluzzi ('083).

**New Grounds of Rejections**

***Claim Rejections - 35 USC § 103***

14. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**15. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asai (JP 2003-1705, cited by Applicant on NPL document, submitted on 7/27/2006) in view of Matsumoto et al. (CN 1406743, cited by Applicant on PTOL-1449 form, filed on 2/19/2008 and having similar disclosure of US 6,779,703, which is covered by examiner for rejection here).**

16. As to claim 1, Asai discloses a press molding apparatus comprising first mold (4); a second mold (3) disposed to face the first mold, wherein first mold (4) is a moveable die which is configured to advance and retreat, and second mold (3) is stationary die (See figure 1). Figure 1 further teaches that the apparatus comprises resin board (A) as a substrate; stamper (8) as a machining member disposed on a side face of the first mold (4) and having irregularities on a surface facing the first mold; load processing section configured to load a to-be-machined member (8) on the first mold (4) (See paragraph #12, 14); a heat processing sections (14, 25) configured to heat the to-be machined member to a molding temperature higher than a state change point of a material which constitute the to-be machined member (See paragraph #15, 19); and transfer processing section for pressing the machining member against the to-be-machined member so as to transfer the

irregularities to the to-be machined member (See paragraph #17, 20). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the invention of Asai by making second mold as a moveable mold for configured to advance and retreat so the substrate can have desired irregularities pattern. As we know that the claiming of new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable, *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

17. As to claim 2, it further teaches that heat processing section (25) is configured to heat the to-be machined member to a preheating temperature lower than the state change point (See paragraph # 23-26).

18. As to claim 4, it further teaches that the heat processing section (14) is configured to heat machining member (8) is disposed between first and second molds such that the heating section faces the machining member (See figure 1).

19. As to claim 5, it further teaches that the heating section is configured to heat machining member (8) is incorporated into the machining member (See figure 1).

20. As to claim 3, it further teaches that the heating section is configured to heat the machining member (8) is disposed between the machining member and the first mold (See figure 1).

21. Thus, Asai discloses all claimed structural limitations as discussed above, but fails to teach or suggest a heat insulating member.

22. Matsumoto et al. discloses a press molding apparatus which comprises first mold (114), second mold (122), substrate (134), heat processing section (116,124) and heat insulating members (118,126), wherein heat insulating member is disposed between molds and heat processing section for preventing heat loss of the heat processing section due to the heat conduction of the heat processing section toward the molds.

23. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the invention of Asai by providing a heat insulator member of Matsumoto et al. for preventing heat loss of the heat processing section, so the machining member and to-be-machined member heated to desired temperature during the transfer processing operation, and, thus to produce the article with desired irregularities.

**24. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. (CN 1406743, cited by Applicant on PTOL-1449 form, filed on 2/19/2008 and having similar disclosure of US 6,779,703, which is**

**covered by examiner for rejection here) in view of Asai (JP 2003-1705, cited by Applicant on NPL document, submitted on 7/27/2006).**

25. Matsumoto et al. discloses a press molding apparatus includes a first mold (114); second mold (122), wherein second mold is configured to retreat and advance (See figure 1); substrate (134) (see figure 1); heat processing section (116,124) configured to heat the to-be-machined member to a molding temperature higher than a state change point of a material which constitute the to-be-machined member (See col.6 lines 26-31); heat insulating members (118,126) disposed on a side of the substrate (134) which side faces the first mold (114) (See figure 1); and transfer processing section configured to press the to-be-machined member (See abstract). It further teaches that the heat processing section is configured to heat to-be-machined member having been heated to a preheating temperature (See col.7 lines 5-10). It further teaches that the heating section is disposed between the heat insulation member and cover plate (See figure 1). Figure 1 further teaches that the cover plate is disposed between first and second mold such that the heating section faces the cover plate. Figure 1 further teaches that the heating section is configured to heat the cover plate is incorporated into the cover plate.

26. Matsumoto et al. discloses all claimed structural limitations as discussed above. It further teaches that the apparatus comprises cover plates

(120,128) for pressing the work-piece, but fails to teach or suggest that the cover plate comprises a machining member with irregularities.

27. Asai discloses a press molding apparatus which comprises a first mold having a machining member with irregularities (See figure 1). It further teaches that load processing section configured to load a to-be-machined member (8) on the first mold (4) (See paragraph #12, 14).

28. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the invention of Matsumoto et al. by providing a machining member of Asai for molding article with desired irregularities.

### ***Conclusion***

29. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 2/19/2008 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the

THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIMPLE N. BODAWALA whose telephone number is (571)272-6455. The examiner can normally be reached on Monday - Friday at 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, PHILLIP C. TUCKER can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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